

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Holness et al. CONFIRMATION NO. 8497
SERIAL NUMBER: 10/666,372 ART UNIT: 2661
FILING DATE: September 19, 2003 EXAMINER: Blount, Steven
TITLE: System and Method for Managing an Optical Networking Service

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) on the attached sheet(s).
Note: no more than five (5) pages may be provided.

I am the attorney of record.

Date: 11/22/2006
Reg. No. 41,274

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This paper responds to the final Office Action mailed from the United States Patent and Trademark Office on August 22, 2006. A Notice of Appeal is being filed concurrently with this paper with authorization to charge Deposit Account No. 50-2295 for the \$500 fee under § 41.20 (b)(1).

History

Previous Office Actions for the subject application were mailed from the U.S. Patent & Trademark Office on February 23, 2005 and August 23, 2005. Applicants filed a Request for Continued Examination (RCE) on December 22, 2005. Subsequent office actions ensued on March 15, 2006 and August 22, 2006.

Remarks

Claims 1-20 were presented for examination. The Office Action rejects Claims 1-3, 5, 8, 10-11, and 13-20 under 35 U.S.C. §103(a) as being unpatentable over Applicants' Admitted Prior Art ("AAPA") in view of U.S. Patent No. 6,594,047 issued to Ballantine et al ("Ballantine") and U.S. Patent No. 6,366,563 issued to Weldon et al ("Weldon"). The Office Action also rejects Claims 4, 6, and 7 as being unpatentable over AAPA in view of Ballantine and Weldon, and further in view of U.S. Patent No. 5,768,255 issued to Brownmiller et al; Claim 9 as being unpatentable over AAPA in view of Ballantine and Weldon, and further in view of U.S. Patent No. 6,731,648 issued to Cotter; and Claim 12 as being obvious over AAPA in view of Ballantine and Weldon and further in view of U.S. Patent No. 5,768,530 issued to Galway et al. Applicants respectfully traverse these rejections.

The Applicants' invention, as set forth in representative independent claim 1, recites, in pertinent part, generating a service performance report message at each termination point. Each service performance report message has service-specific information related to a performance of the service as determined by a service termination point generating that service performance report message. Each service performance report message identifies the service

to which the service-specific information in that service performance report message pertains. A termination point transmits its service performance report message to the other termination point.

Applicants respectfully submit that the Examiner has omitted essential elements required to establish a *prima facie* rejection. More specifically, Applicants refer to two elements and limitations (paraphrased in pertinent part) missing from the cited references:

- (1) A service performance report (SPR) message generated at each termination point, each SPR message has service-specific information related to a performance of the service; and
- (2) each SPR message identifies the service to which the service-specific information in that SPR message pertains.

In rejecting claim 1, the Examiner cites a portion of the Applicants' own Background as admitted prior art, but without indicating which elements of the Applicants' claims that the cited portion is purported to disclose. Notwithstanding, the cited portion does not disclose any of the above-identified elements and limitations.

As a secondary reference, the Examiner cites Ballantine because Ballantine teaches a solution to transmitting OAM (operations, administration, and management) data between different networks. However, the Examiner is unclear in his present explanation as to which limitations of the Applicants' claims he considers Ballantine to teach or disclose and or how Ballantine is to be combined with the AAPA. Instead, the Examiner relies generally on "well known" principles for isolating and

segmenting faults, without indicating whether Ballantine or some other reference is the source of these “well-known” principles and without applying them specifically to any particular claim element. Then, the Examiner identifies those elements and limitations of the claims that are missing from the combination of the AAPA and Ballantine, leaving the Applicants to speculate on how the Examiner is combining the references. As a result, the Applicants cannot clearly identify the issues in order to fairly contest the proposed combination.

In addition, the Examiner does not support the basis of his belief – see page 3 of the Final Office Action dated 8/23/2005 – that the Applicants’ service-specific information is merely an obvious variant of Ballantine’s “performance monitoring, and/or administration, and or maintenance information.” Applicants respectfully submit that a “belief” leaves no fair opportunity for rebuttal, except to express strong disagreement and to reiterate that Ballantine’s performance monitoring is of the transport facility that carries the signals, and is not specific to any service. Moreover, in the present Final Office Action the Examiner does not expressly address the service-specific information limitation. It is unclear to the Applicants whether the Examiner no longer holds to this belief or if some other, unidentified portion of Ballantine is instead considered to disclose or teach the service-specific information.

With respect to the second item listed above, the Examiner acknowledges that the AAPA and Ballantine do not disclose or teach identifying the service in each SPR message and relies on Weldon for this feature. However, when relying on Weldon, the Examiner has subtly changed the claimed limitation to identifying “the type of service.” This is an inappropriate reading of a limitation into the Applicants’ claim. Moreover, it

is incorrect characterization of Weldon. For instance, the Examiner considers the file name “latency.log” to be an example of an identifier of the “type of service.” However, the name “latency.log” does not identify a service, or even a type of service, it merely identifies the type of file (it is a log file). Furthermore, a processor (223) creates and sends this latency.log file to a customer – it is not included in any probe message exchanged between source and destination probe routers. Therefore, even if the name “latency.log” could somehow be considered an identifier of a service, Weldon cannot be reasonably considered to teach or suggest including such a “service identifier” in service performance report messages generated at and transmitted between termination points, as set forth in the Applicants’ claims.

Although Applicants have focused on two missing elements and limitations, Applicants respectfully reserve the right to argue others in the event the application proceeds to appeal. Other independent claims include similar limitations.

Conclusion

In view of the remarks made herein, Applicants respectfully submit that essential elements needed for a *prima facie* rejection have not been met. Thus, Applicants request early favorable action by the Panel.

Respectfully submitted,

Date: November 22, 2006
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